



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,081	09/25/2003	Janani Janakiraman	AUS920030585US1	6289
45993	7590	07/31/2008		
IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123			EXAMINER THERIAULT, STEVEN B	
			ART UNIT	PAPER NUMBER
			2179	
			MAIL DATE	DELIVERY MODE
			07/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,081	Applicant(s) JANAKIRAMAN ET AL.	
	Examiner STEVEN B. THERIAULT	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10-12,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-7, 10-12, 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communications: Amendment filed 04/10/2008.
2. Claims 1 -2, 5-7, 10-12, 15-16 are pending in the case. Claims 1, 6, and 11 are the independent claims. Claims 3-4, 8-9, 13-14 are the cancelled claims. MPEP 706.07 (a) provides for the following:

“When applying any 35 U.S.C. 102(e)/103 references against the claims of an application the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP §706.02(l)(3). “

Therefore, this rejection is non-final.

Response to Amendment

3. The declaration submitted 04/10/2008 should have been submitted as a separate paper as required by 37 CFR 1.4(c). The paper has been entered. However, all future correspondence must comply with 37 CFR 1.4. Further, 37 CFR 1.111 or 1.132 are used to reply to an office action or when any claim of an application or patent is rejected or objected to, where any evidence is submitted to traverse the rejection or objection on a basis not otherwise provided, must be by way of an oath or declaration under 1.132, 37 CFR 1.121 does not provide a basis for providing a declaration. 1.121 provides for the manner in which amendments to the claims and/or specification are made. A remarks section is not provided for under 1.121 and even so MPEP 706.02 (I) (2) (II) “Evidence required to establish common ownership” states the declaration should be on a separate paper and separately labeled. The declaration is a part of the claim amendment document and not a separate paper. Nonetheless and as stated above, the declaration has been entered but future correspondence where a declaration or evidence is needed should be submitted under 37 CFR 1.132 or 1.111 to reply to a non-final office action and on a separate paper.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1 -2, 5-7, 10-12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challapali et al. (hereinafter Challapali) U.S. Publication No. 20020194006 filed Mar. 29, 2001, in further view of Richardson et al. (hereinafter Richardson) U.S. Patent No. 5812126 filed Dec. 31, 1996.**

Art Unit: 2179

In regard to **Independent claim 1**, Challapali teaches a computer-implemented method of communicating ~~emotional aspects associated with a communication session from a first person to a second person, said method comprising the steps of:~~

- ~~Receiving an emotional state indicator output from automatic one or more emotional characteristic indicators from at least one~~ emotional content analyzer performed on said of a communication session from ~~[[said]] a first person to a plurality of recipients, wherein each recipient is to receive a copy of said communication session~~ (See Para 009, 0011, 0020-0025). Challapali teaches a chat system with a plurality of recipients, where each person has the same software and hardware and content is analyzed and presented to the chat participants in the form of an emoticon where the emotion is represented as a facial expression.
- ~~For each recipient, determining an appropriate emoticon or other symbol to reflect said emotional state~~ (See figure 2 and 3). Challapali teaches that each person facial movements are expressed through the chat system as they respond to the content in the chat window. Challapali lists several emotional responses (See also appendix on page 3 and 4).
- ~~For each copy to each recipient, merging said emoticon or symbol into said communication session copy~~ (See Figure 2 and 3, and Para 0026-0029). Challapali teaches merging the emotion with the text into an emoticon that is shown to all other participants as the user responds (See also appendix on page 3 and 4).
- ~~Presenting said communication session, emoticons, and symbols to each of said plurality of recipients wherein each recipient receives symbols~~ (See Para 0023- 0024). Challapali teaches simulating facial movements and emotions to each of the other users in the interface (See also figures 2 and 3).
~~generating one or more electronic symbols representing said overall emotion, said electronic symbols being interpretable by said second person; and presenting said electronic symbols to said second person in association with said communication session.~~

Challapali does not expressly teach:

- ~~identifying-retrieving a profile for said first person and said second person; retrieving a plurality of profiles corresponding to each of said recipients; determining an overall emotional state for said first person relative to said first person's identity and said received emotional content analysis results; determining the emoticon or symbol in a manner consistent with each recipient profile and presenting emoticons and symbols to a plurality of recipients consistent with their own profile.~~

However, Richardson teaches a process of retrieving a profile for a person (See Figure 3, 310 and column 6, lines 1-20). Richardson teaches retrieving profiles from a user profiles database (See figure 2, 245 and column 3, lines 60-67 and column 4, lines 50-67 and column 5, lines 1-15).

Richardson teaches a process of allowing a user to masquerade online and present emoticons based on their profile (See column 6, lines 21-60 and column 7, lines 10-41). Richardson and Challapali are analogous art because they both teach a process of expressing emotion in

Art Unit: 2179

communications between users via conversations online. They both address the problem of conveying emotion in email or chat by relating an emotion to an input provided to the users collaborating with the user.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Richardson and Challapali in front of them, to modify the system of Challapali with the system of Richardson to present the emoticons of Challapali to other participants based on a user profile. The motivation to combine Richardson with Challapali comes from the suggestion in Richardson to transform a users input into a form that corresponds to one or more user specified characteristics (See column 1, lines 45-61). More specifically, Richardson expressly suggests the motivation to use a user profile in a chat session where the user profile is used to transform the user input into an output corresponding to the profile (See column 3, lines 35-40) and where the user profile is used to track a person's identity and represent it to others in a chat session (See column 4, lines 59-67 and column 7, lines 30-40).

With respect to **dependent claim 2**, Challapali teaches the computer-implemented method wherein said step of receiving output of emotional content analysis comprises receiving the results of a process selected from the group of a hand gesture recognizer, a body movement recognizer, a voice pitch analyzer, and a facial expression recognizer (See Challapali Para 005, 0011 and 0020-0025). Challapali teaches presenting content that has been analyzed by the system through a facial expression and presents to the other chat users the emoticon and text related to the response (See also figure 2 and 3 and Para 29).

With respect to **dependent claim 5**, Challapali teaches a computer-implemented method wherein said step of generating one or more electronic symbols corresponding to said overall emotional state comprises generating an electronic symbol selected from the list of a text-based emoticon, a graphical emoticon, a text highlight method, a text size change, a text underlining method, a text bolding method, one or more signals for a Telephone Terminal for the Deaf system, and a Braille

Art Unit: 2179

code (See Para 0031, Challapali shows the list of text and graphical emotions that will be shown to the plurality of users).

In regard to **claims 6, 7, and 10**, claims 6, 7 and 10 reflect the article of manufacture comprising computer readable instructions for performing the method steps of claims 1, 2 and 5, respectively, and are rejected along the same rationale.

In regard to **claims 11, 12, and 15**, claims 11, 12 and 15 reflect the system comprising computer readable instructions for performing the method steps of claims 1, 2 and 5, respectively, and are rejected along the same rationale.

With respect to **dependent claim 16**, Challapali teaches the system wherein said symbol merger is configured to merge a communication session selected from the group of an electronic mail message, an online text chat, a video conference, a online classroom, a captioned television broadcast, a multimedia presentation, and an open captioned meeting (See Para 005 and 017, chat system).

Response to Arguments

Applicant's arguments with respect to claims 1 -2, 5-7, 10-12, 15-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M, W, F 10:00AM - 8:00 PM.

Art Unit: 2179

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven B Theriault/
Patent Examiner
Art Unit 2179